

REMARKS

Claims 1, 3-30 and 33-42 are pending. Claims 2, 31 and 32 are canceled. Claims 1 and 30 have been amended herein. No new matter is added by these amendments. Support for the amendments to Claims 1 and 30 can be found at least at page 5, lines 2-6 and page 11, lines 15-18 of the specification as filed, and by Claim 29 as filed.

CLAIM REJECTIONS - 35 U.S.C. §103(a)

I. Hunt in view of Williams

The instant Office Action states that Claims 1, 3-19, 26-28, 30, 33-35 and 37-39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hunt et al. (U.S. Patent No. 5,835,716; hereinafter “Hunt”) in view of Williams et al. (U.S. Patent No. 6,560,509; hereinafter “Williams”). Applicants have reviewed the above-cited art and respectfully submit that the embodiments as recited in Claims 1, 3-19, 26-28, 30, 33-35 and 37-39 are patentable over Hunt in view of Williams for at least the following rationale.

A. Claims 1, 3-19, 26-28, 30-33, 35 and 37-39

Independent Claim 30, and similarly independent Claim 1, recites the features (emphasis added):

A method comprising:
...
automatically selecting one of said plurality of carrier entries based on an attribute of said demand entry; and
automatically booking said selected carrier entry in response to said demand entry.

Applicants understand Hunt to teach:

The system operator selects an appropriate matched entry which must then be confirmed. Upon confirmation, selected matches are saved to a transaction database and assigned a transaction code.

Abstract of Hunt (emphasis added); see also, Figure 3B steps 218 and 220; Figure 3C step 242; col. 9, lines 21-24; and col. 9, lines 10-14. Applicants understand Williams to teach “[t]he particular order may be automatically assigned to a carrier” Abstract of Williams (emphasis added).

The instant Office Action states:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of selecting and booking a carrier of Hunt, to be automated as disclosed as Williams, because the use of known techniques of automating the selection and booking of a carrier would have been obvious to one of ordinary skill in the art.

See the instant Office Action, page 3, section 5.

Applicants respectfully submit that “[i]t is improper to combine references where the references teach away from their combination.” MPEP § 2145(X)(D)(2) (emphasis added), citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Applicants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP § 2141.02(VI) (emphasis in original), citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Applicants respectfully submit that there is no motivation to modify Hunt in view of Williams at least because Hunt teaches away from the suggested modification.

In particular, Applicants respectfully submit that the requirement of Hunt that, subsequent to “operator selection” of “an appropriate matched entry”, the selected entry “must then be confirmed” (Abstract of Hunt (emphasis added)) teaches away from the modification of automatically booking a selected entry. Indeed, Applicants respectfully submit that a process or system of “automatically selecting...” and “automatically booking...” a selected entry, as recited in Claim 30 and similarly in Claim 1, necessarily precludes execution of the step of an operator selecting an entry and entering the selection and the step of receiving confirmation of a selected entry, as required by Hunt (Abstract of Hunt see also, Figure 3B steps 218 and 220; Figure 3C step 242; col. 9, lines 21-24; and col. 9, lines 10-14). In the response to arguments section (section 38, pages 9 and 10) of the present office action, it has been argued that, “Hunt ...never discloses who does the confirming.” However, it is clear from the language of Hunt that a system operator does the selecting, (see, col. 9, lines 21-24 and col. 9, lines 10-14 of Hunt).

For at least the foregoing rationale, Applicants respectfully submit that Claims 1 and 30 are patentable over Hunt in view of Williams and that these claims overcome the rejection under 35 U.S.C. §103(a). As such, allowance of Claims 1 and 30 is respectfully requested.

With respect to Claims 3-19 and 26-28, Applicants respectfully point out that

Claims 3-19 and 26-28 depend from allowable independent Claim 1, and recite further features. With respect to Claims 33-35 and 37-39, Applicants respectfully point out that Claims 33-35 and 37-39 depend from allowable independent Claim 30, and recite further features. Therefore, Applicants respectfully submit that Claims 3-19, 26-28, 33-35 and 37-39 overcome the rejections under 35 U.S.C. §103(a), and that these claims are thus in a condition for allowance as being dependent on an allowable base claim. As such, allowance of Claims 3-19, 26-28, 33-35 and 37-39 is respectfully requested.

B. Claims 5 and 34, Unsupported Official Notice

The foregoing notwithstanding, the instant Office Action states:

Hunt ... fails to disclose the logic unit allows a user to define a subgroup within the exchange system, and assign unrestricted access to only members of the subgroup. The examiner takes official notice that the use of defining a group who has unrestricted access to the system is old and well known in the art.

See the instant Office Action, page 7, section 25 (emphasis added).

Applicants respectfully submit that the instant Office Action has provided inadequate support of a finding of Official Notice. The “assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support.” MPEP § 2144.03(A), citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Indeed, “[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.” MPEP § 2144.03(E), citing *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 421 (CCPA 1970)). Per MPEP §2144.03 (A), “...assertions

of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art” (emphasis added). In re Ahlert, 424 F.2d at 1091, 165 USPQ at 420-21. See also In re Grose, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979).

Per this guidance of the MPEP, Applicants submit that the Office Action has inappropriately taken official notice of technical facts or specific knowledge without providing support by citation. Applicants submit that proper support must be given in order for Applicants to determine an appropriate response, if any. The Office Action appears to be attempting to shift the burden of response to the applicant prior to and without satisfying the Office’s initial burden of citation of support. Accordingly, Applicants respectfully request that the Examiner provide adequate evidence in the form of an affidavit in support of the finding of Official Notice, in accordance with 37 CFR § 1.104(d)(2) or a citation which supports the Official Notice.

II. Hunt in view of Williams and in further view of Nel

The instant Office Action states that Claims 20-25, 29, 36 and 40-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hunt in view of Williams, and in further view of Nel (U.S. Patent Application Publication No. 2003/0036935). Applicants have reviewed the above-cited art and respectfully submit that the embodiments as recited in Claims 20-25, 29, 36 and 40-42 are patentable over Hunt in view of Williams, and in further view of Nel, for at least the following rationale.

Claims 20-25 and 29 are dependent on independent Claim 1 and include the features of Claim 1. Claims 36 and 40-42 are dependent on independent Claim 30 and include the features of Claim 30. Hence, by demonstrating that Hunt in view of Williams, and in further view of Nel, does not teach or suggest the features of Claims 1 and 30, it is also demonstrated that Hunt in view of Williams, and in further view of Nel, does not teach or suggest the embodiments of Claims 20-25, 29, 36 and 40-42.

Independent Claim 30, and similarly independent Claim 1, recites the features (emphasis added):

A method comprising:
...
automatically selecting one of said plurality of carrier entries based on an attribute of said demand entry; and
automatically booking said selected carrier entry in response to said demand entry.

As stated above, Applicants respectfully submit that there is no motivation to modify Hunt in view of Williams at least because Hunt teaches away from the suggested modification. Similarly, assuming arguendo that Nel or Williams in view of Nel teaches or suggests “automatically selecting one of said plurality of carrier entries based on an attribute of said demand entry; and automatically booking said selected carrier entry in response to said demand entry,” as claimed, Applicants nevertheless respectfully submit that there is no motivation to modify Hunt in view of Williams, and in further view of Nel, at least because Hunt teaches away from the suggested modification of “automatically selecting” and “automatically booking” a selected entry.

For at least the foregoing rationale, Applicants respectfully submit that Claims 1 and 30 are patentable over Hunt in view of Williams, and in further view of Nel, and allowable over the rejection under 35 U.S.C. §103(a).

With respect to Claims 20-25 and 29, Applicants respectfully point out that Claims 20-25 and 29 depend from allowable independent Claim 1, and recite further features. With respect to Claims 36 and 40-42, Applicants respectfully point out that Claims 36 and 40-42 depend from allowable independent Claim 30, and recite further features. Therefore, Applicants respectfully submit that Claims 20-25, 29, 36 and 40-42 overcome the rejections under 35 U.S.C. §103(a), and that these claims are thus in a condition for allowance as being dependent on an allowable base claim. As such, allowance of Claims 20-25, 29, 36 and 40-42 is respectfully requested.

CONCLUSION

In light of the above-listed remarks, reconsideration of the rejected claims is requested. Based on the arguments presented above, it is respectfully submitted that Claims 1, 3-30 and 33-42 overcome the rejections of record. Therefore, allowance of Claims 1, 3-30 and 33-42 is respectfully solicited.

Should the Examiner have a question regarding the instant response, the Applicants invite the Examiner to contact the Applicants' undersigned representative at the below-listed telephone number.

Respectfully submitted,
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